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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,158	03/19/2001	Robert L. Battey	10961158-2	2950

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 02/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,158

Applicant(s)

BATTEY ET AL.

Examiner

Michael P Nghiem

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[□] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16, 17, and 20-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,699,091 in view of U.S. Patent No. 6,142,617 and U.S. Patent No. 6,168,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because even though Bullock et al. ('091) does not claim that the electrical contacts are on the first side of the leading edge and the fluid outlet is on the second side of the leading edge, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to relocate the electrical

contacts to the first side of the leading edge and the fluid outlet to the second side of the leading edge as disclosed by Barinaga et al. ('617) and Clark et al. ('262) for the purpose of separating the electrical contacts from the fluid outlet.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-20 and 26-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ujita et al. (US 5,506,611).

Ujita et al. discloses all the claimed features of the invention including:

- a replaceable ink container (21, 51) for use in an off axis printing system (Fig. 10), the printing system being responsive to electrical signals produced by the replaceable ink container for controlling printing system parameters (Fig. 5), the replaceable ink container having a leading edge (front wall of 51, Fig. 5) defined as that edge of the replaceable ink container first received by the printing system, the replaceable ink container comprising:

- a plurality of electrical contacts (19a, 19b) on the leading edge at a first side of the leading edge, the plurality of electrical contacts configured for engaging a plurality of corresponding electrical printer contacts of the printing system (20a, 20b);

- a fluid outlet (15) on the leading edge at a second side of the leading edge that is directly opposite to the first side such that the fluid outlet is separated from the plurality of electrical contacts (15 is separated from 19a, 19b), the fluid outlet being in fluid communication with the replaceable ink container and configured for engaging a fluid inlet (16) of the printing system; and

- an information storage device (22) electrically connected to the plurality of electrical contacts;

- the leading edge defines a longitudinal axis with the first side and the second side being disposed on the longitudinal axis (Fig. 5);

- a latch feature (2641, 2642), the replaceable ink container having an unlatched position and a latched position, wherein the latch feature is in engagement with corresponding engagement features (336a, 337a) of the printing system, the plurality of electrical contacts of the replaceable ink container are in engagement with the plurality of corresponding electrical printer contacts, and the fluid outlet is in fluid communication with the fluid inlet of the printing system (Figs. 27a, 27b);

- the latch feature is a pair of latch features, and wherein one latch feature of the pair of latch features is on the replaceable ink container adjacent to the first side and another latch feature of the pair of latch features is on the replaceable ink container adjacent to the second side (Figs. 27a, 27b).

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-0956.


Michael Nghiem

February 4, 2002